

BoxInterferences@uspto.gov  
Telephone: 571-272-4683

Paper 1  
Declared: 21 July 2008

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

Patent Interference 105,650 McK  
Technology Center 1600

---

AMGEN, INC.  
(Inventors: Anthony J. Polverino and Roland Luethy),  
Patent 7,329,729 B1,  
Junior Party,

v.

GENENTECH, INC.  
(Inventors: Audrey Goddard, Paul J. Godowski, Austin L. Gurney,  
Victoria Smith, Colin K. Watanabe and William I. Wood),  
Application 10/143,114,  
Senior Party.

---

Before: Fred E. McKelvey, *Senior Administrative Patent Judge*.

DECLARATION

Part A  
Declaration of Interference

An interference is declared pursuant to 35 U.S.C. § 135(a).  
Details of the application, patent, count and claims designated as  
corresponding or as not corresponding to the count appear in Parts E and F.

1 Part B  
2 Designation to manage  
3

4 Senior Administrative Patent Judge Fred E. McKelvey has been  
5 designated to manage the interference. 37 CFR § 41.104(a).

6  
7 Part C  
8 Standing Order  
9

10 A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)  
11 accompanies this DECLARATION.

12 The STANDING ORDER applies to this contested case.

13 Part D  
14 Initial Conference Call and Motions Lists  
15

16 Conference Call

17 A conference call to set dates for action in this contested case is  
18 scheduled for:

19 2:00 p.m. (1400 hours Eastern Time) on 03 September 2008.

20 The Board will initiate the conference call.

21  
22 Motions Lists

23 On or before:

24 Noon (1200 hours Eastern Time) on 28 August 2008,  
25 each party shall file, and on or before:

26 5:00 p.m. (1700 hours Eastern Time) on 28 August 2008,  
27 each party shall serve a notice stating the relief the party requests, *i.e.*, a  
28 motions list including motions the party seeks authorization to file. 37 CFR  
29 §§ 41.120(a) & 41.204; STANDING ORDER ¶¶ 104.2.1, 120 & 204.

1       The default procedure for filing and serving motions lists is that  
2 motions lists are to be *filed* before being *served*.

3       By filing before service, one party will not have access to an  
4 opponent's motions list prior to the filing of the party's motions list.

5       Nevertheless, the parties may mutually agree to discuss and serve  
6 motions lists at any time prior to the date and time motions lists are due.

7       The following shall be included in motions lists.

8               (1)   Proposed motion for benefit (*i.e.*, to be accorded an  
9 earlier constructive reduction to practice) must identify the application(s) for  
10 which benefit will be sought.

11              (2)   Proposed motion to attack benefit must identify the  
12 application(s) to be attacked.

13              (3)   Proposed motion seeking judgment against an opponent  
14 based on alleged unpatentability must identify the statutory basis for the  
15 alleged unpatentability and:

16                   (a)   if based on prior art, identify the prior art;

17                   (b)   if based on the first paragraph of 35 U.S.C. § 112,  
18 (i) identify whether written description, enablement or best mode will be the  
19 basis for the motion, and (ii) briefly identify the basis for any alleged  
20 unpatentability;

21                   (c)   if based on an alleged failure to comply with  
22 35 U.S.C. § 135(b), briefly identify the reason;

23                   (d)   if based on the second paragraph of 35 U.S.C.  
24 § 112, identify the limitation which is believed to be indefinite.

25              (4)   Proposed motion based on no interference-in-fact shall  
26 briefly identify the reason no interference-in-fact is believed to exist.

1                   (5)   Proposed motion to designate additional claims as  
2 corresponding to a count or as not corresponding to a count shall identify the  
3 claims involved.

4                   (6)   Proposed motion to add or substitute a new count shall  
5 explain why the added or substitute count is necessary.

6           A motions list shall not contain any "reservation clause" whereby a  
7 party purports to reserve a right to file additional motions. Additional  
8 motions are those authorized by the Board consistent with the rules.

9           A sample schedule for taking action during the motions phase of the  
10 interference appears as Form 2 (page 69) of the STANDING ORDER.

11          Counsel are encouraged to discuss the schedule prior to the  
12 conference and agree to on times for taking action generally consistent with  
13 the sample schedule.

14          A typical motions phase last about eight (8) months.

15          The parties should be prepared at the conference to justify any request  
16 for shorter or longer time periods.

1 Part E

2  
3 Identification of the Parties  
4 Assignment of Exhibit Numbers  
5 Initiating Settlement Discussions  
6

7 Junior Party

8  
9 Inventors: Anthony J. Polverino, CA  
10 Roland Luethy, CA

11  
12 Patent: U.S. Patent 7,329,729 B1,  
13 issued 12 Feb. 2008,  
14 based on application 09/724,000,  
15 filed 28 November 2000  
16

17 Title: Secreted epithelial colon stromal-1  
18 molecules and uses thereof  
19

20 Real party in interest: Amgen, Inc.  
21

22 Senior Party

23  
24 Inventors: Audrey Goddard, CA  
25 Paul J. Godowski, CA  
26 Austin L. Gurney, CA  
27 Victoria Smith, CA  
28 Colin K. Watanabe, CA  
29 William I. Wood, CA  
30

31 Application: 10/143,114,  
32 filed 09 May 2002  
33

34 Title: The PRO3446 polypeptides  
35

36 Real party in interest: Genentech, Inc.

1                                    Assignment of Exhibit Numbers

2            Senior party:            Exhibit Numbers 1001 through 1999.

3            Junior party:            Exhibit Numbers 2001-2999.

4            Board:                    Exhibit Numbers 3001-3999.

5

6                                    Initiating Settlement Discussions

7                                    STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

8

9            The senior party is responsible for initiating settlement discussions  
10 required by the STANDING ORDER.

11

                                  Part F

12

                                  Count 1 and Claims of the Parties

13

Count 1

14

                                  A composition of matter according to claim 77 of application

15

10/143,114 or a composition of matter according to claims 1, 2, 4, 7

16

or 10 of patent 7,329,729 B1.

17

The claims of the parties are:

18

                                  Amgen:                    1-12

19

                                  Genentech:            77-78 and 82-84

20

The claims that correspond to Count 1 are:

21

                                  Amgen:                    1-12

22

                                  Genentech:            77-78 and 82-84

23

The claims that do not correspond to Count 1 are:

24

                                  Amgen:                    None

25

                                  Genentech:            None

1           The parties are accorded an earlier constructive reduction to practice  
2   (*i.e.*, benefit for the purpose of priority) of the following applications:

3                   Amgen:           Application 09/599,087,  
4                                       filed 21 June 2000

5  
6                   Genentech:       application 10/028,072,  
7                                       filed 19 December 2001

8  
9                                       PCT US00/32678,  
10                                      filed 01 December 2000

11  
12                                     provisional application 60/170,262,  
13                                     filed 09 December 1999

Part G  
Heading to be Used on Papers

The following heading shall be used on all papers filed in this  
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper \_  
[Name of attorney] Date filed: [enter date emailed to Board]  
[Email address of attorney]  
[Telephone number of attorney]

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

Patent Interference 105,650 McK  
Technology Center 1600

---

AMGEN, INC.  
(Inventors: Anthony J. Polverino and Roland Luethy),  
Patent 7,329,729 B1,  
Junior Party,

v.

GENENTECH, INC.  
(Inventors: Audrey Goddard, Paul J. Godowski, Austin L. Gurney,  
Victoria Smith, Colin K. Watanabe and William I. Wood),  
Application 10/143,114,  
Senior Party.

Title of Paper, *e.g.*, [Name of party] MOTION 1



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12

Part H  
Order Form for Requesting File Copies

When requesting file copies, a party shall use STANDING ORDER Form 4 (page 71).

Use of form 4 will expedite processing of any request.

A party should attach to any request for file copies a photocopy of Part E (for involved files) and Part F (for benefit files) of this DECLARATION with a hand-drawn circle around the patent and application files for which a copy of a file wrapper is requested.

The parties are advised that a single order for file copies may be filled by the Office of Public Records at different times. STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).

1 Part I  
2 Required Paragraph of Affidavits and Declarations  
3

4 The Board has experienced cases in which a witness has belatedly  
5 advanced reasons why the witness would be unable to appear for cross  
6 examination at a reasonable time and place in the United States.

7 Consequently, to prevent surprise and hardship to the party relying on  
8 the testimony of a witness, the following paragraph must be included on the  
9 signature page of all affidavits (including declarations) filed in this case.

10 STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

11  
12 In signing this [affidavit] [declaration], I understand that the  
13 [affidavit] [declaration] will be filed as evidence in a contested  
14 case before the Board of Patent Appeals and Interferences of  
15 the United States Patent and Trademark Office. I acknowledge  
16 that I may be subject to cross examination in the case and that  
17 cross examination will take place within the United States. If  
18 cross examination is required of me, I will appear for cross  
19 examination within the United States during the time allotted  
20 for cross examination.

1 (via Federal Express and electronic mail):

2  
3 Attorney for Amgen:

4  
5 McDonnell Boehnen Hulbert & Berghoff LLP  
6 300 S. Wacker Drive  
7 32<sup>nd</sup> Floor  
8 Chicago, IL 60606

9  
10 Tel: 312-913-0001  
11 Fax: 312-913-0002  
12 Email: [docketing@mbhb.com](mailto:docketing@mbhb.com)

13  
14 Attorney for Genentech:

15  
16 Goodwin Procter LLP  
17 135 Commonwealth Drive  
18 Menlo Park, CA 94025

19  
20 Tel: 650-752-3100  
21 Fax: 650-853-1038  
22 Email: [Patentsv@goodwinprocter.com](mailto:Patentsv@goodwinprocter.com)